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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/569,492 | 02/27/2006 | Nobuo Naito | 127199 | 3472 |
| 25944 7590 04/21/2010 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER | | | | |
| CHANG, VICTOR S | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1783 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 04/21/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
jarnstrong@oliff.com

Office Action Summary

Application No.

10/569,492

Applicant(s)

NAITO ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 6-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 2/2/2010 have been entered. Claim 4 has been amended. Claims 4 and 5 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, newly added limitation "optionally a coloring agent for color tone adjustment" renders the scope of the claimed invention vague and indefinite, because it redefines an earlier limitation "a coloring agent for color tone correction" as being optional, not a required element. Clarification is required in the next reply.

Rejections Based on Prior Art

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa et al. (US 6090473) in view of Ozawa (US 6638624).

Yoshikawa's invention relates to an electromagnetic wave shielding and light transmitting plate suitable for a front filter of a plasma display panel [col. 1, ll. 8-10]. Fig. 6a illustrates an embodiment of the filter comprising successively an antireflective layer 65, a transparent substrate 62A, and an adhesive layer 64 [col. 17, ll. 15-22]. The adhesive layer may include small amounts of ultraviolet absorbing agent, infrared absorbing agent, and coloring agent, etc. [col. 11, ll. 19-22].

For claims 4 and 5, since Yoshikawa's filter is inherently transparent for viewing the plasma display, the base resins used are necessarily transparent. Yoshikawa lacks a teaching of forming a discrete transparent resin layer which consists of a near infrared absorbing agent, and an adhesive layer consists of a coloring agent for color tone correction. However, Ozawa's invention relates to a filter for plasma display panel, and teaches that the filter can have additional layers, such as a near-infrared (IR) absorbing layer, an antireflection layer, and the like. These layers may be provided in an arbitrary order. See col. 15, ll. 27-32. It would have been an obvious modification to one of ordinary skill in the art to modify Yoshikawa with a separate layer, which consists of a near infrared absorbing agent in a transparent resin, between the transparent substrate and the adhesive layer which consists of a coloring agent for color tone correction, as taught by Ozawa. The selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination.

Terminal Disclaimer

7. The terminal disclaimer filed on 2/2/2010 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat. Appl. Nos. 10/562,424 and 10/569,512 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

8. In view of the updated grounds of rejection, since the collective teachings of prior art render the structure and composition of the claimed invention obvious as set forth above, applicants' argument directed to Yoshikawa individually is unpersuasive.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1783